

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Hearing:

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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re James Hardie Research Pty., Limited

Serial No. 75/265,610

William G. Lane, Esq. for James Hardie Research Pty.,
Limited.

Karen A. McGee, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney)

Before Walters, Bottorff and Holtzman, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark FIRE X, in typed form, for "fire resistant
grade gypsum board for interior wall and ceiling
application."¹

¹ Serial No. 75/265,610, filed March 28, 1997. The application is based on use in commerce under Trademark Act Section 1(a), and applicant has alleged July 1988 as the date of first use of the mark anywhere and first use of the mark in commerce. Applicant has asserted, and the Trademark Examining Attorney has accepted, a claim of acquired distinctiveness under Trademark Act Section 2(f).

The Trademark Examining Attorney has issued a final refusal of registration on the ground that applicant's mark, as applied to its goods, so resembles the mark depicted below,

which is registered on the Principal Register for "lumber which has been impregnated with a fire-retardant chemical,"² as to be likely to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).³

Applicant has appealed the final refusal. Applicant and the Trademark Examining Attorney filed main briefs, and applicant filed a reply brief. An oral hearing was held,

² Registration No. 1,037,082, issued March 30, 1976. Affidavits under Sections 8 and 15 accepted and acknowledged. Renewed under Section 9 in 1996.

³ Initially, the Trademark Examining Attorney also issued two additional refusals. The first was a Section 2(d) refusal based on Registration No. 1,082,107, which is of the mark FIRE-X GLASBORD for "glass fiber reinforced plastic panels." That refusal was withdrawn in the second office action. The second additional refusal was on the ground of mere descriptiveness under Trademark Act Section 2(e)(1). That refusal was withdrawn upon the Trademark Examining Attorney's acceptance of applicant's claim of acquired distinctiveness under Section 2(f). Neither of those additional refusals is at issue in this appeal.

at which the Trademark Examining Attorney and applicant's counsel presented arguments.

In reaching our decision herein, we have carefully considered all of the rather extensive evidence which applicant and the Trademark Examining Attorney properly made of record during prosecution of the application, including any evidence which is not specifically discussed in this opinion. However, we sustain the Trademark Examining Attorney's timeliness objection to applicant's Exhibits G and H, which were attached to applicant's appeal brief, and we have not considered that evidence. See Trademark Rule 2.142(d).⁴

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in

⁴ Exhibits G and H are essentially cumulative of the other evidence applicant made of record, as applicant itself has acknowledged. Our exclusion of this evidence has had no effect on our decision herein.

the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to the issue of whether applicant's mark and registrant's mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We find that applicant's FIRE X mark and registrant's stylized FIRE-X mark are identical in terms of sound and connotation, and that they are highly similar in terms of appearance notwithstanding the slight stylization of registrant's mark. Overall, we find that the respective marks present highly similar, if not identical, commercial impressions, as applied to the goods identified in

applicant's application and registrant's registration.⁵
This *du Pont* evidentiary factor weighs heavily in favor of
a finding of likelihood of confusion.

We consider next the relationship between the goods
identified in applicant's application and those identified
in registrant's registration. It is not necessary that
these respective goods be identical or even competitive in
order to support a finding of likelihood of confusion.
Rather, it is sufficient that the goods are related in some
manner or that the circumstances surrounding their
marketing are such that they would be likely to be
encountered by the same persons in situations that would
give rise, because of the marks used thereon, to a mistaken
belief that they originate from or are in some way
associated with the same producer or that there is an
association or connection between the producers of the
respective goods. See *In re Melville Corp.*, 18 USPQ2d 1386
(TTAB 1991); *In re International Telephone & Telegraph
Corp.*, 197 USPQ 910 (TTAB 1978). Moreover, the greater the

⁵ Applicant argues that the marks are distinguishable because
registrant's FIRE-X mark, as actually used by registrant, is
always preceded by the term EXTERIOR. However, our determination
must be based on a comparison of the marks as they appear in
registrant's registration and on applicant's application drawing
page, respectively. *In re Shell Oil Co.*, 992 F.2d 1204, 26
USPQ2d 1687, 1690 at n.4 (Fed. Cir. 1993); *Interstate Brands
Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000).

degree of similarity between the parties' marks, the lesser the degree of similarity required in the parties' goods to support a finding of likelihood of confusion, and where the parties' marks are essentially identical, there need be only a viable relationship between their respective goods in order to find that a likelihood of confusion exists.

See In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

In support of her contention that applicant's goods are related to registrant's goods, the Trademark Examining Attorney has submitted printouts of eight subsisting use-based registrations, owned by six different companies,⁶ which include both lumber and gypsum board in their respective identifications of goods. These registrations are evidence that the respective goods are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). In further support of this conclusion, the Trademark Examining Attorney has submitted numerous excerpts of articles

⁶ The six owners of these registrations are: Temple-Inland Forest Products Corporation; Georgia-Pacific Corporation; Domtar, Inc.; Huttig Sash & Door Corporation; Republic Gypsum Company; and The Wickes Corporation.

obtained from the NEXIS® automated database which refer to companies that market both lumber and gypsum board.⁷ In all, it appears from the Trademark Examining Attorney's evidence that at least nine companies market both lumber and gypsum board.⁸

Applicant makes several arguments challenging the relevance and probative value of the Trademark Examining Attorney's third-party registration and NEXIS® evidence, none of which is persuasive. First, applicant argues that those registrations and articles cover a period extending back over twenty years, that there has been a consolidation of the gypsum board industry over that period, and that many of the companies identified in the registrations and articles no longer exist and/or no longer manufacture gypsum board. However, we note that of the thirteen "surviving" U.S. manufacturers of gypsum board identified

⁷ The companies to which various of the articles refer are National Gypsum, Georgia-Pacific, Domtar, Inland, Alpine International, and General-Pacific.

⁸ The NEXIS® excerpts refer to three companies which are not among the six owners of the third-party registrations, i.e., National Gypsum, Alpine International and General-Pacific. We presume that the "Inland" referred to in one of the NEXIS® excerpts is Temple-Inland Forest Products Corporation, the owner of two of the third-party registrations submitted by the Trademark Examining Attorney.

in applicant's Exhibit D-3,⁹ four, i.e., National Gypsum, Georgia-Pacific, Republic, and Temple-Inland, also are identified in the Trademark Examining Attorney's third-party registration and NEXIS® evidence as companies which market both lumber and gypsum board.¹⁰ Moreover, even assuming that applicant's evidence proves that some of the companies identified in the Trademark Examining Attorney's third-party registrations and NEXIS® articles do not manufacture gypsum board at this time, it does not prove that those companies do not market gypsum board, as well as lumber, under their respective marks.

Applicant also challenges the Trademark Examining Attorney's third-party registration and NEXIS® evidence on

⁹ Exhibit D-3, which is attached to and identified in paragraph 12 of the second declaration of applicant's Technical Services Manager Rob Davies, is a copy of an unidentified document which sets out the logos or marks of the following "Gypsum Association Member Companies": American Gypsum; Atlantic Group Limited; Celotex; Continental Gypsum Company; G-P Gypsum Corporation [this logo contains the stylized "G-P" mark registered by Georgia-Pacific Corporation - see *supra* at footnote 7]; James Hardie Gypsum [the applicant]; Lafarge Gypsum; National Gypsum Company; PABCO Gypsum; Republic Gypsum Company; Temple [this logo includes the stylized mark registered by Temple-Inland Forest Products Corporation, see *supra* at footnote 7, and includes the words "A Temple-Inland Company"]; United States Gypsum Company; and BPB Westroc.

¹⁰ See *supra* at footnotes 6-9. Moreover, one of the companies identified in the Trademark Examining Attorney's evidence as a marketer of both lumber and gypsum board in the United States is Domtar, Inc., a Canadian company which presumably would not be included in applicant's list of the thirteen U.S. manufacturers of gypsum board.

the ground that, although the registrations and articles refer to companies which market both lumber and gypsum board, they do not refer specifically to the "specialty" goods involved in this case, i.e., fire-resistant gypsum board and lumber treated with a fire-retardant chemical. However, we presume that the broad terms used in the third-party registrations' identifications of goods, i.e., "lumber" and "gypsum board," include and thus are legally identical to, respectively, registrant's "lumber treated with a fire-retardant chemical" and applicant's "fire-resistant grade gypsum board for interior wall and ceiling application." *Cf. In re Diet Center Inc.*, 4 USPQ2d 1975 (TTAB 1987); *cf. also Shunk Manufacturing Company v. Tarrant Manufacturing Company*, 137 USPQ 881 (CCPA 1963). Applicant has presented no evidence to the contrary. Likewise, there is nothing in the record which suggests that the "lumber" and "gypsum board" to which the NEXIS® articles refer should not be presumed to include fire-retardant lumber and fire-resistant gypsum board.

In sum, we are not persuaded by applicant's challenges to the Trademark Examining Attorney's third-party registration and NEXIS® evidence. That evidence suggests that there are at least nine companies which market both lumber and gypsum board in commerce under their respective

marks, and it supports a finding, under the second *du Pont* factor, that these goods are similar. See *In Re Albert Trostel, supra*, and *In re Mucky Duck Mustard, supra*.

In addition to the third-party registrations and NEXIS® evidence of record, which establishes the source-relatedness of lumber and gypsum board, the record also includes evidence which shows that fire-resistant gypsum board such as applicant's and fire-retardant-treated lumber such as registrant's are complementary products which may be used in direct conjunction with each other in construction projects requiring a specific degree of fire resistance. First, applicant's Exhibit D-2 (to the Davies II declaration) consists of excerpts from the Uniform Building Code. At pages 1-81 and 1-82, in the Code's Table 7-B, "Rated Fire-Resistive Periods for Various Walls and Partitions," Item Nos. 17-1.4, 17-1.6 and 18-1.6 specifically provide for the use of "fire-retardant-treated wood studs" in conjunction with "Type-X gypsum wallboard."¹¹ Second, on registrant's web page, made of record as Exhibit E to applicant's request for reconsideration, registrant states that its FIRE-X lumber "is frequently used in

¹¹ As applicant has acknowledged, applicant's "fire-resistant grade" gypsum board is Type-X gypsum wallboard. See the evidence attached to the Trademark Examining Attorney's first office action, and applicant's response thereto.

combination with other materials for applications requiring fire resistive and non-combustible construction, and to reduce insurance rates." The Board reasonably presumes that such "other materials" include Type-X gypsum board such as applicant's. Finally, applicant's declarant John L. Mulder acknowledged that although lumber such as registrant's is not interchangeable with gypsum board such as applicant's, "the lumber might be used over gypsum board for a decorative finish."

This evidence of the complementary nature of applicant's and registrant's respective "fire-resistive" or "fire-retardant" building products further supports a finding that these goods are related, for purposes of the second *du Pont* evidentiary factor. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984)("[s]uch complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion").

Applicant's primary and repeatedly emphasized contention on the issue of the relatedness of the respective goods is that lumber and gypsum board are different products which would never be confused for each other by any purchaser. According to applicant, the two products are of completely different material composition;

they have different properties, uses and functions; they accordingly are not interchangeable and, under building and fire codes, they would not and cannot legally be substituted for each other; and they are installed by different craftspersons employing different and specialized skills, tools and installation methods. In paragraph 8 of his second declaration, applicant's employee Rob Davies states:

Architects select and specify materials of construction, and contractors and developers order such materials. These professionals know that lumber is used for one purpose and gypsum board for another. They know that one cannot be substituted for the other. I find it inconceivable that anyone in the building trades would specify lumber impregnated with a fire-retardant chemical for fire-resistant grade gypsum board because of building code requirements and because the materials are so different and have different characteristics, functions, and purposes.

Applicant's argument misses the point. The issue is not whether lumber and gypsum board are different and distinguishable from each other, or whether purchasers are likely to be confused into mistakenly purchasing or ordering applicant's gypsum board instead of registrant's lumber, or vice versa. Rather, the issue is whether lumber and gypsum board are sufficiently commercially related that, when they are marketed under the essentially

identical marks involved herein, purchasers are likely to assume that the two products originate from a single source. See *In re Melville Corp.*, *supra*, and *In re International Telephone & Telegraph Corp.*, *supra*.

Based on the evidence in the record which shows that lumber and gypsum board can be and are marketed by a single source under a single mark, and that applicant's and registrant's goods are complementary products, we find that the requisite commercial relationship between the respective products exists. Furthermore, the presence of this evidence regarding the commercial relationship between applicant's and registrant's goods suffices to distinguish the present case from the case relied on by applicant, *In re American Olean Tile Company Inc.*, 1 USPQ2d 1823 (TTAB 1986), in which the Board expressly noted that no such evidence was of record.

For the reasons discussed above, we find that applicant's goods and registrant's goods are similar rather than dissimilar, for purposes of the second *du Pont* evidentiary factor. These goods are sufficiently commercially related that confusion is likely to result from the concurrent use thereon of applicant's and registrant's essentially identical marks.

The next *du Pont* evidentiary factor to consider is the similarity or dissimilarity of the trade channels for goods of the types identified in the application and in the cited registration. Applicant's declarant Mr. Davies stated that gypsum board and lumber are "for the most part" advertised in different trade journals and trade shows. (Davies II, paragraph 11.) However, he also acknowledged that lumber such as registrant's and gypsum board such as applicant's both are offered for sale at, inter alia, lumberyards and at home improvement centers such as Home Depot. (Davies II, paragraph 10.) We find that this evidence of the existence of an overlap in the distribution channels and retail outlets for the respective goods weighs in favor of a finding of likelihood of confusion under the third *du Pont* evidentiary factor.

As for the next evidentiary factor, i.e., the conditions under which and the buyers to whom sales of these respective products are made, applicant argues that the goods are expensive and that the bulk of purchasers of these goods are sophisticated professionals. However, there is no evidence in the record as to exactly how expensive these goods are, and applicant acknowledges that ordinary consumers are among the purchasers and users of these goods. (Davies II, paragraph 10.) Moreover, even

assuming that the purchasers of these goods are primarily professionals, we cannot conclude from this record that these purchasers are particularly sophisticated when it comes to the trademarks for such goods. There is no evidence to that effect; the evidence of record as to the sophistication of purchasers suggests only that purchasers are aware of the differences between lumber and gypsum board, per se, and would not confuse the two products. In sum, the evidence of record as to this *du Pont* factor is neutral, at best, and it does not weigh heavily in our analysis.

In addition to applicant's lengthy and detailed arguments and evidentiary submissions regarding the differences between lumber and gypsum board, applicant's other primary argument in this case pertains to the issue of actual confusion. Applicant asserts that it is aware of no instances of actual confusion between applicant's and registrant's marks despite the applicant's and registrant's twelve years of concurrent use of their respective marks on their respective goods, and argues that the absence of such evidence of actual confusion strongly indicates that no likelihood of confusion exists. We are not persuaded.

The evidence of record shows that applicant has marketed its FIRE X product in all states west of the Rocky

Mountains (including Colorado and New Mexico) since 1988, and, since February 1997, in all states of the United States except for the Dakotas, Minnesota, Wisconsin, the Upper Peninsula of Michigan, and the New England states. (Davies II, paragraph 14.) Since 1988, applicant has sold 40 million sheets of its FIRE X gypsum board, upon which the mark has been prominently displayed. (Davies II, paragraphs 13 and 14.)

It also appears from the record that registrant has headquarters in Thomson, Georgia, and has three manufacturing plants, in Georgia, Arkansas and Virginia. See the 1981 specimens submitted with registrant's Section 8 affidavit (Exhibit A to applicant's request for reconsideration). It also appears from registrant's 1998 catalog (Exhibit C to reconsideration request; Exhibit D-5 to Davies II declaration) that as of 1998, at least, registrant's "fire retardant formulations are licensed to a select group of licensee treating plants" in Michigan, Quebec, Oregon and Utah. Finally, it appears that one of the Oregon licensees (in Jasper, Oregon) was identified as using registrant's FIRE-X mark in January 1988. (Exhibit D-4 to Davies II declaration.)

We cannot determine from this evidence that there has been any substantial geographic overlap in the parties' use

of their respective marks. Applicant relies on an asserted twelve years of concurrent use by the parties, but applicant's use during the majority of that time (from 1988 to 1997) was solely in the states west of the Rocky Mountains. There is no evidence as to the extent of use, if any, of the registered mark in that region, during that time period, by registrant or its licensee(s).¹² Likewise, we cannot determine from the record what percentage, if any, of applicant's asserted sales since 1988 of 40 million sheets of gypsum board have occurred in states east of the Rocky Mountains. Thus, we cannot conclude from this record that the opportunity for actual confusion has been so significant that its asserted absence is of particular probative value in our likelihood of confusion analysis.

We also have considered applicant's arguments as to two additional *du Pont* factors, i.e., the extent to which it has the right to exclude others from the use of its mark

¹² The evidence suggests that registrant had a licensee using the mark in Jasper, Oregon in January 1988. That licensee also is named in registrant's 1998 catalog. Even if we assume, *arguendo*, that use of the mark by that licensee was continuous from 1988 to 1998, there is no evidence regarding the dollar amount and geographic extent of the licensee's use. As for the other licensees identified in registrant's 1998 catalog, there is nothing in the record which establishes that they had been using registrant's mark prior to 1998. Indeed, it is not clear from the record that those licensees are even using the registered mark. Registrant's catalog states only that they are licensees of registrant's "fire retardant formulations."

and the extent of potential confusion, but we are not persuaded that those factors are entitled to significant weight, vis-à-vis the other factors of record, in our likelihood of confusion analysis.

We have carefully considered all of the evidence of record pertaining to the *du Pont* evidentiary factors, as well as applicant's arguments with respect thereto, and we conclude that the evidence warrants a finding that confusion is likely. The marks are essentially identical. The goods, although not identical or interchangeable, are complementary goods of the type which may be sold by a single source under a single mark. The goods move in the same trade channels and are sold to the same classes of customers, including to ordinary consumers. The purchasers of these goods have not been shown to be so sophisticated as to trademarks or so careful in their purchasing decisions that they are unlikely to be confused as to the source of the products, even assuming, as applicant contends, that they would not confuse the products themselves. In these circumstances, the absence of actual confusion is not dispositive, especially inasmuch as it does not appear that there has been a significant opportunity for actual confusion to have occurred.

In summary, we find that a likelihood of confusion exists. To the extent that applicant, by its evidence or arguments, may have raised any doubts as to this conclusion, such doubts must be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register is affirmed.

C. E. Walters

C. M. Bottorff

T. E. Holtzman

Administrative Trademark Judges
Trademark Trial and Appeal Board